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10/054,617	11/09/2001	Mark Scott McCoy	MC0Y-001COA	9302

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EXAMINER

WALLS, DIONNE A

ART UNIT

PAPER NUMBER

1731

DATE MAILED: 08/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/054,617

Applicant(s)

MCCOY, MARK SCOTT

Examiner

Dionne A. Walls

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 and 13-17 is/are pending in the application.
- 4a) Of the above claim(s) 1-7 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16 and 17 is/are allowed.
- 6) ☒ Claim(s) 8-10, 14-15 is/are rejected.
- 7) ☒ Claim(s) 13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 8-10, and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kretzner (US. Pat. No. 1,957,143) in view of Groulx (US. Pat. No. 2,129,129) and Carabias (US. Pat. No. 933,360).

Kretzner discloses all that is recited in the claims (Note: "a" corresponds to the claimed "lower chamber member"; "c" corresponds to the claimed "bowl portion"; "z" corresponds to the claimed "vapor intake orifice"; "e"/ "f"/ tubular part of "a" correspond to the claimed "vapor intake conduit"; "d" corresponds to the claimed "smoking pipe conduit"; "b" corresponds to the claimed "upper chamber member") except it may not specifically disclose a lower screen member disposed in the bowl portion of the lower chamber and a generally-conical-shaped heat intake conduit. However, Groulx discloses a screen for tobacco pipes which is adapted to be inserted into the bowl of a tobacco pipe for holding tobacco clear from the bottom of the pipe bowl (see figs). Therefore, would have been obvious to one having ordinary skill in the art at the time of the invention to modify the bowl of Kretzner to include the metal screen of Groulx in order to prevent tobacco particles from being drawn into the mouth, and also from plugging or clogging the passage through the stem and through which the smoke is

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drawn, as taught in Groulx (see page 1, col. 1, lines 12-16). Also, while the device of Kretzner modified by Groulx may not disclose an upper chamber member including a generally-conical-shaped heat intake conduit, Carabias discloses an inhaler in the form of a smoking pipe which has a bowl B, the outlet of which is shaped in a generally conical manner (see fig. 3). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the outlet portion of the upper chamber member of Kretzner (which would obviously be adapted to accept an output from a heat source such as a match or heat gun) such that it resembled the cone shape outlet of the pipe in Carabias since a pipe having a bowl outlet of said shape is known in the tobacco art as evidence by the disclosure of Carabias. Lastly, while there may be no articulation, in the combined references, that the lower and upper chambers are mated in a substantially airtight manner, it follows that this is the case since the chambers are joined in such a manner where in they are mated by external/internal threads on the surfaces of the respective members, such threading being conventional means in which to secure/connect two pieces in an airtight manner.

Regarding claim 15, while the device of the combined references may not have the exact threaded structure of that claimed, this limitation is not deemed to patentably distinguish the claim from the reference as the surfaces utilized to mate the two members together are obvious modifications since it is well known to utilize these means in securing items together – whether the threading is located on the exterior or interior of the respective pieces.

***Allowable Subject Matter***

3. Claim 13 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
4. Claims 16- 17 are allowed.

***Response to Arguments***

1. Applicant's arguments filed May 30<sup>th</sup>, 2003 have been fully considered but they are not persuasive.

- Applicant argues that the claimed invention eliminates the elements of radial channels "f" and the tubular part of shell "a" while retaining the function of directing vapor to the smoking piece, and because of such, is an indication of non-obviousness. However, the Examiner disagrees. The Examiner believes that all of the elements cited in the Kretzner reference "e"/"f" and the tubular part of "a" correspond to the claimed "vapor intake conduit", meaning that these elements allow the vapor to be delivered to the smoker. The fact that Applicant's claimed invention doesn't require the elements of "a" and "f" does not mean that a reference containing these elements cannot read on the claims. All that is required is that the reference disclose a device which is structurally able to serve as a "vapor intake conduit". That a reference may not have the same number of elements/parts as that of the instant invention is not a proper reason to invalidate the use of a reference.

- In response to Applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by

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combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the Kretzner reference suggests all that is recited in the claims, but there may no specific articulation of a lower screen member. The Groulx reference, however, provides us with a general teaching that screen members for positioning within the bowl of tobacco pipes are known in the art. The purpose of which, is clear – to prevent tobacco particles from being drawn into the mouth, and also from plugging or clogging the passage through the stem and through which the smoke is drawn. One having ordinary skill in the art would have been motivated to modify the pipe of Kretzner by placing a screen, such as that disclosed in Groulx, within the pipe bowl to receive the benefits – such as those taught in Groulx. Further, since Caribias discloses a device which can be used as a smoking pipe, having a bowl with a conical shape. One having ordinary skill in the art would have modified the bowl of the pipe of Kretzner modified by Groulx, to one having a conical shape as an aesthetic or design choice since such shape is known – from the Carabias disclosure. For these above reasons, the Examiner believes that the combination of the Kretzner/Groulx and Carabias references are proper.

- Applicant argues that the Carabias reference has no teaching or suggestion to modify a smoking pipe to accept an output nozzle of a heat gun. The Examiner disagrees. Since there is no indication in the instant specification how an output is

structured to "accept an output nozzle of a heat gun" is any different from a conically shaped output, such as is disclosed in Caribias, the Examiner assumes that a conically shaped output is structurally sufficient to read on the claims. The Examiner believes that the inherent conical nature of such a bowl outlet would allow it to be capable of accepting an output nozzle of a heat gun, as is claimed. Where the claimed and prior art product/apparatus is identical or substantially identical in structure or composition, a *prima facie* case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430,433 (CCPA 1977). In other words, when the structure recited in the reference is substantially identical to that of the claims, the claimed properties or functions (i.e. adaptability to accept an output nozzle of a heat gun) are presumed to be inherent. Further, Applicant has not articulated dimensions or parameters that would be specific to an heat intake orifice suitable for the particular purpose of accepting an output nozzle of a heat gun.

### ***Conclusion***

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

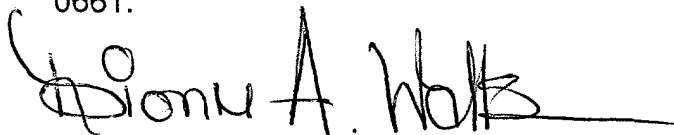
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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne A. Walls whose telephone number is (703) 305-0933. The examiner can normally be reached on Mon-Fri, 7AM - 4:30PM (Every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on (703) 308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

A handwritten signature in black ink that reads "Dionne A. Walls". The signature is written in a cursive, flowing style with a long horizontal line extending to the right.

Dionne A. Walls  
August 11, 2003